

Appl. No. : **10/726,256**
Filed : **December 2, 2003**

COMMENTS

Claims 33-41, 43-46 and 74-86 remain pending in the present application, Claims 33, 36, 38 and 45 having been amended. The claims set forth above include marking to show the changes made by way of the present amendment, deletions being in ~~strikeout~~ and additions being underlined.

In response to the Office Action notified January 25, 2008, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Amendments to the Claims Add No New Matter

Applicants have amended Claims 33, 36, 38 and 45 to correct typographical errors. The amendments are supported the drawings, for example, Figs. 3, 4, 6, 7 and 8 and the related descriptions in the specification.

Smith Does Not Qualify as a Prior Art

Claims 33-35, 37, 43, 44, 46 and 74-86 were rejected under 35 U.S.C. § 102(b or e) as being anticipated by Smith (U.S. Patent No. 6,311,843) or under 35 U.S.C. § 103(a) as obvious over Smith. Applicants respectfully traverse the present rejection and submit that Smith is in fact not prior art under 35 U.S.C. §§ 102 (b or e) nor 103(a) with respect to pending Claims 33-35, 37, 43, 44, 46 and 74-86.

Firstly, with respect to the outstanding rejection under 35 U.S.C. § 102(b), Applicants wish to point out that the present Application is a Divisional Application of U.S. Patent Application No. 09/690,790, filed October 17, 2000, now Patent No. 6,675,973 B1 which claims priority to U.S. Provisional Patent Application No. 60/227,724, titled **SUSPENSION PACKAGING ASSEMBLY, filed July 31, 2000**. Claims 33-35, 37, 43, 44, 46 and 74-86 are supported by the disclosure of Provisional Patent Application No. 60/227,724, and thus, are entitled to the July 31, 2000 filing date.

Smith, on the other hand, according to the front page thereof, was first published on its issue date, November 6, 2001. Thus, Smith does not qualify as a prior art under 35 U.S.C. § 102(b).

With regard to the remaining rejections, Applicants submit that because Applicants reduced to practice the inventions of Claims 33-35, 37, 43, 44, 46 and 74-86, the Smith reference is also not available as prior art under 35 U.S.C. §§ 102(e) or 103(a). Further, as

Appl. No. : **10/726,256**
Filed : **December 2, 2003**

described in and thus cannot be relied on for rejecting any of these claims under that section or 35 U.S.C. §§ 102(e) or 103(a).

As noted above, Applicants hereby submit that Applicants reduced to practice the inventions of Claims 33-35, 37, 43, 44, 46 and 74-86 prior to October 1, 1999, the filing date of the Smith reference. Thus, the Smith reference is not available as prior art under 35 U.S.C. §§ 102(e) or 103(a). As such the present rejection is moot.

As evidence of Applicant's reduction to practice October 1, 1999, Applicants have submitted herewith a signed declaration under 37 CFR § 1.131 including a copy of a letter from William H. Shreve of Knobbe Martens Olson & Bear LLP dated May 28, 1999. This letter instructs the recipient to conduct a patentability search and includes a sketch of an embodiment of the subject matter recited in the Claims.

Applicants thus submit that since at least one embodiment of the rejected claims was reduced to practice prior to October 1, 1999, (the filing date of Smith), Smith does not qualify as a prior art under 35 U.S.C. § 102(e).

Because Smith does not qualify as a prior art under 35 U.S.C. § 102, it also cannot qualify as prior art under 35 U.S.C. § 103(a). Accordingly, there being no other outstanding rejection of these claims, Applicants submit that Claims 33-35, 37, 43, 44, 46 and 74-86 are currently in condition for allowance.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any

Appl. No. : **10/726,256**
Filed : **December 2, 2003**

undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 27, 2008

By: /Michael Guiliana/

Michael A. Guiliana
Registration No. 42,611
Attorney of Record
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404

5387454_1
052708

EXHIBIT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	McDonald et al.
Appl. No.	:	10/726,256
Filed	:	December 2, 2003
For	:	SUSPENSION PACKAGING ASSEMBLY
Examiner	:	Jacob K. Ackun
Group Art Unit	:	3728

DECLARATION PURSUANT TO 37 C.F.R. § 1.131**Mail Stop Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This declaration is to establish an invention date of embodiments claimed in the above-captioned patent application prior to October 1, 1999, the filing date of U.S. Patent No. 6,311,843 B1 to Smith et al. ("Smith").

We, John McDonald, Myles Comerford and Frank Comerford, do declare as follows:

1. We are the named inventors of the above-captioned patent application and are familiar with the prosecution of the application.
2. We believe that the facts set forth below show that we conceived and reduced to practice embodiments of the claimed invention in the above-identified application, at least prior to October 1, 1999.
3. As evidence of the reduction to practice of the claimed invention, we provide herewith **Exhibit A**.
4. We created a prototype of an embodiment of the claimed invention at least prior to October 1, 1999. We believe that the prototype was a reduction to practice of the claimed invention. The prototype was a packaging assembly that includes two frames and two sleeves. Each frame has two wall structures opposing each other. Each wall structure has a triangular-shape in section. Open sides of each frame are formed between the wall structures. When

forming the packaging assembly with the two frames, the wall structures of one of the two frames are disposed in the open sides of the other. The sleeves are made of a resilient material. Each of the sleeves receives each of the frames to form a subassembly. In the subassembly, the resilient retention portion of the sleeve extends between the wall structures. When packaging an article, the subassemblies nest with each other such that the article is interposed between the retention portions of the sleeves.

5. **Exhibit A** is a copy of a letter from William H. Shreve at Knobbe Martens Olson & Bear LLP dated May 28, 1999 prior to the filing date of Smith, which is October 1, 1999. We asked Mr. Shreve to conduct a patentability search on the packaging assembly described in the foregoing paragraph before May 28, 1999. Mr. Shreve sent the letter to Stanley Schwartz at Schwartz and Weinrieb, enclosing some drawings with short descriptions. Among the drawings, Figure 2 (a) shows an open-sided frame and a tube or sleeve. The frame has two wall structures opposing each other and two open sides between the wall structures. The wall structure has a triangular shape in section. Figure 2 (b) shows that the sleeve receives the frame to form a subassembly and further shows that an article is supported between the two subassemblies to form a packaging assembly.

6. This declaration is being submitted after the final Office Action dated January 25, 2008 as Smith was first cited by the Examiner in the final Office Action.

//
//
//
//
//
//
//
//
//
//
//
//

Appl. No. : 10/726,256
Filed : December 2, 2003

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: April 25, 2008 By: John McDonald
John McDonald

Dated: APRIL 25, 2008 By: Myles Comerford
Myles Comerford

Dated: April 25, 2008 By: Frank Comerford
Frank Comerford

5022621
042208

INTELLECTUAL PROPERTY LAW

KNOBBE, MARTENS, OLSON & BEAR

A LIMITED LIABILITY PARTNERSHIP INCLUDING
PROFESSIONAL CORPORATIONS

PATENT, TRADEMARK AND COPYRIGHT CAUSES

620 NEWPORT CENTER DRIVE

SIXTEENTH FLOOR

NEWPORT BEACH, CALIFORNIA 92660-8016

(949) 760-0404

FAX (949) 760-9502

INTERNET: WWW.KNOB.COM

LEE W. HENDERSON
DEBORAH S. SHEPHERD
RICHARD C. CAMPBELL
MARK M. ABUMERI
JOH W. GURKA
KATHERINE W. WHITE
JOSEPH J. BASISTA
ERIC M. NELSON
ALEXANDER C. CHEN
MARK R. BENEDICT
PAUL N. CONOVER
JOHN P. MUSONE
ROBERT J. ROBY
SABING H. LEE
KAROLINE A. DELANEY
JOHN W. HOLCOMB
JAMES J. MULLEN, III
JOSEPH S. CIANFRANI
JOSEPH M. REISMAN
WILLIAM R. ZIMMERMAN
GLEN L. NUTTALL
ERIC S. FURMAN
DO TE KIM
TIRZAH ABE LOWE
GEOFFREY Y. IIDA
ALEXANDER S. FRANCO
SANJIVPAL S. GILL
SUSAN M. MOSS
GUY PERRY

OF COUNSEL
JERRY R. SEILER

JAPANESE PATENT ATTY
KATSUHIRO ARAI**

EUROPEAN PATENT ATTY
MARTIN HELLEBRANDT

KOREAN PATENT ATTY
MINCHEOL KIM

SCIENTISTS & ENGINEERS
(NON-LAWYERS)

RAIMOND J. SALENIEKS**
MICHAEL L. FULLER**
NEIL S. BARTFELD**
DANIEL E. JOHNSON**
JEFFERY KOEPKE
KHURRAM RAHMAN
JENNIFER A. HAYNES
BRENDAN P. O'NEILL
MARRINA Q. WEI
THOMAS Y. HAGATA
ALAN A. GORDON
IRFAN A. LATEEF
AMY C. CHRISTENSEN
SHEILA N. SWAROOP

LOUIS J. KNOBBE*
DON W. MARTENS*
GORDON H. OLSON**
JAMES B. BEAR
DARRELL L. OLSON*
WILLIAM B. BUNKER
WILLIAM H. NIEMAN
LOWELL ANDERSON
ARTHUR S. ROSE†
JAMES F. LESNIAK
NED A. ISRAELSEN
DREW S. HAMILTON
JERRY T. SEWELL
JOHN B. SGANGA, JR.
EDWARD A. SCHLATTER
GERARD VON HOFFMANN
JOSEPH R. RE
CATHERINE J. HOLLAND
JOHN M. CARSON
KAREN VOGEL WEIL†
ANDREW H. SIMPSON
JEFFREY L. VAN HOOSEAR
DANIEL E. ALTMAN
ERNEST A. BEUTLER
MARGUERITE L. GUNN
STEPHEN C. JENSEN
VITO A. CANUSO III
WILLIAM H. SHREVE
LYNDA J. ZADRA-SYMES**

STEVEN J. NATAUPSKY
PAUL A. STEWART
JOSEPH F. JENNINGS
CRAIG S. SUMMERS
ANNEMARIE KAISER
BRENTON R. BABCOCK†
THOMAS F. SMEGAL, JR.
MICHAEL H. TRENHOLM
DIANE M. REED
JONATHAN A. BARNEY
RONALD J. SCHOENBAUM
JOHN R. KING
FREDERICK S. BERRETTA
NANCY WAYS VENSKO
JOHN P. GIEZENTANNER
ADEEL S. AKHTAR
THOMAS R. ARNO
DAVID N. WEISS
DANIEL HART
JAMES T. HAGLER
DOUGLAS G. MUEHLHAUSER
LORI L. YAMATO
STEPHEN M. LOBBIN
ANN A. BYUN
ROBERT F. GAZDZINSKI
FRED C. HERNANDEZ
STACEY R. HALPERN†
MICHAEL K. FRIEDLAND
DALE C. HUNT

May 28, 1999

VIA FACSIMILE

Stanley Schwartz, Esq.
Schwartz & Weinrieb
1109 Crystal Plaza, Building 1
2001 Jefferson Davis Highway
Arlington, Virginia 22202

Re:

Our Reference No. FCMCCG.002A

Dear Stan:

Please conduct a patentability search

REDACTED

275 BATTERY STREET
SUITE 1840
SAN FRANCISCO, CALIFORNIA 94111
(415) 954-4114
FAX (415) 954-4111

501 WEST BROADWAY
SUITE 1400
SAN DIEGO, CALIFORNIA 92101-3505
(619) 235-8550
FAX (619) 235-0176

3801 UNIVERSITY AVENUE
SUITE 710
RIVERSIDE, CALIFORNIA 92501
(909) 781-9231
FAX (909) 781-4507

* A PROFESSIONAL CORPORATION
† ALSO MEMBER OF D.C. BAR
** ALSO BARRISTER AT LAW (U.K.)
** U.S. PATENT AGENT

Stanley Schwartz, Esq.

May 28, 1999

Page -2-

REDACTED

I look forward to receiving the search results as soon as possible.

Very truly yours,

A handwritten signature in cursive script that reads "Bill".

William H. Shreve

Enclosures

E:\DOCS\WHS\WHS-1394.DOC
052899

REDACTED

REDACTED

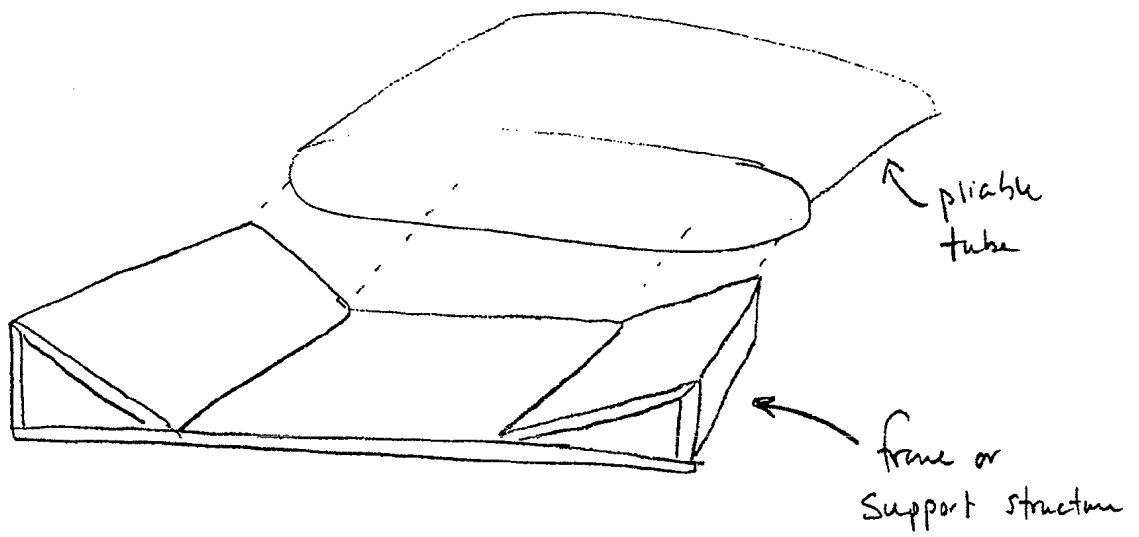
REDACTED

REDACTED

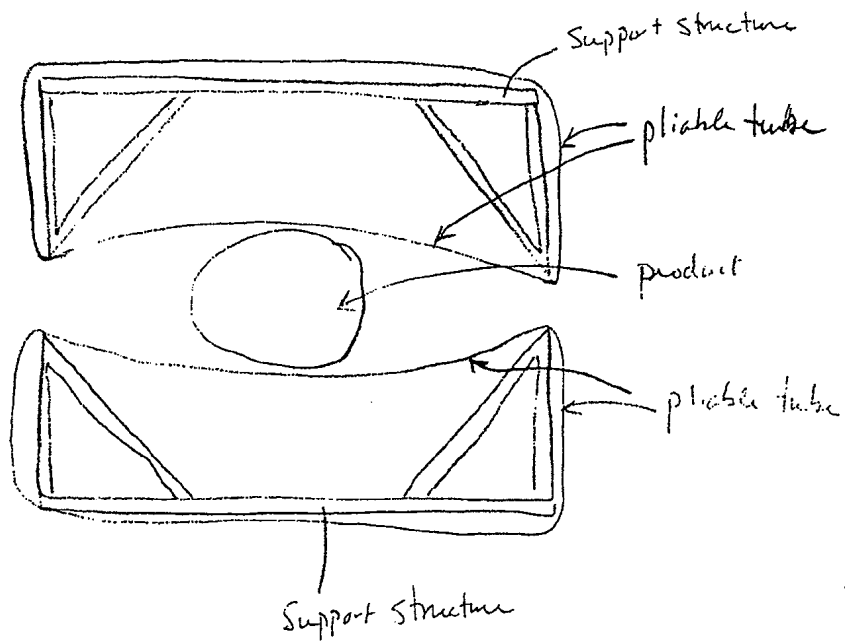
REDACTED

REDACTED

REDACTED



(a) packaging components



(b) Assembly with product between two support structures

Figure 2

REDACTED